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In the Supreme Court of the United States

OCTOBER TERM, 1937.

THE SCHRIBER-SCHROTH COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 674.

THE ABERDEEN MOTOR SUPPLY COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 675.

THE F. E. ROWE SALES COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 676.

BRIEF OF RESPONDENTS ON THE PETITION FOR CERTIORARI

It is manifest from the "Specification of Errors" (pp. 15 and 16 of the Petition) that the rule applicable in the instant case was stated by this Court in *Keller v. Adams-Campbell*, 264 U. S. 314, 319, 320, as follows:

"Such an ordinary patent case, with the usual issues of invention, breadth of claims, and noninfringement,

this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent. We therefore find ourselves mistaken in assuming that an important issue of general patent law under Sec. 4916, Rev. Stat. (Comp. Stat. Sec. 9461, 7 Fed. Stat. Anno. 2d ed. p. 211), is here involved. The result is that an order must be entered dismissing the writ of certiorari as improvidently granted, at the costs of the petitioner. *Layne & B. Corp. v. Western Well Works*, 261 U. S. 387, 67 L. ed. 712, 43 Sup. Ct. Rep. 422; *Furness, W. & Co. v. Yang-Tsze Inc. Asso.*, 242 U. S. 430, 61 L. ed. 409, 37 Sup. Ct. Rep. 141; *United States v. Rimer*, 220 U. S. 547, 55 L. ed. 578, 31 Sup. Ct. Rep. 596."

(1) **The Decisions of the Courts of Appeals are in Harmony in the Instant Cause** (92 Fed. (2) 330 (C. C. A. 6); 17 Fed. (2) 686 (C. A. D. C.); 47 Fed. (2) 365, 366, 367 (C. C. P. A.)): In the 17 Federal (2) and in the 47 Federal (2) cases all the lower tribunals were shown to be in accord with the appellate courts; little weight can be given the decision of the District Court in the instant cause because, the Court of Appeals said that to do so "may prove to be an unsafe guide to just decision where exceptions to a Master's report are unilluminated by oral argument and a decree entered without elucidation of the reasons upon which it is based." (R. p. 2389.) Where the Master differed from these appellate Courts, the differences were differences in law. It is extremely doubtful whether it is correct to say that the Master is in discord with all of these other Courts since his holding was not that Gulick had broadened his disclosure, but only that he had made an "attempt" to do so; all the other tribunals—except, of course, the District Judge—have held that Gulick had not broadened his disclosure. Unless, therefore, this finding of the Master of an "attempt" to do something be construed to be the doing of that thing, the Master and the District Judge are not in discord with the three Courts of Appeals.

(2) No Public Interest: There is even less public interest in the instant cause than in the ordinary patent infringement cause such as *Keller v. Adams, supra*, or any number of other patent causes certiorari in which are denied monthly.

Of the seven devices charged to infringe, but one was specifically held by the Court of Appeals to infringe. In other proceedings Petitioners contend that the Court of Appeals held that the other six did not infringe. Three licenses have been granted under the patents in suit and the three licensees have always been and are prepared to supply all the public's needs for the patented pistons at reasonable prices. Many other kinds and types of pistons are available to the public; some of these were never patented and on many others the patents have expired. Among these are the Franquist and Spillman, *et al.* patents which Petitioners praise so highly and to which Petitioners attach so much importance. Many motor makers, such as The Ford Motor Company and General Motors Corporation, are using non-infringing pistons in many of their cars.

The alleged public interest urged by Sterling Products Corporation, here in the stead of the Petitioners, is no more than a desire of Sterling to be permitted to continue to duplicate, even to their most minute details, the various piston structures patented by Respondent, just as Sterling has been duplicating such structures from time to time in the past as they have been invented, patented and marketed by Respondent and its licensees. (R. pp. 84, 129, 130 and 1327.)

Alleged Pooling of Patents: As in this Court, the Petitioners in the Court of Appeals pressed, with many repetitions, its claim of "patent pool," but the Court of Appeals said no more than that the Respondent "is the

repository of numerous patent rights assigned to it by inventors" and others (R. p. 2383); it is not, therefore, a patent pool even to the extent of the grouping of patents found *legal* by this Court in the *Oil Cracking* case, 283 U. S. 163. Owing to the numerous defenses that may be interposed in a patent suit—such as was done here (R. p. 2384)—and to the need of references to Masters due to overworked District Judges, individual inventors cannot meet the expenses of such records as that of the instant suit. Hence, they have united their interests, just as others such as workingmen, stockholders, etc. are doing to meet modern conditions; that is all that has been done here and it is for, and not against, public policy, since it provides inventors a way to realize remedies which the public intended they should have and of which they would, otherwise, be deprived by the longer purse of the infringers.

The issue of "patent pooling" is not raised by the pleadings here, and is not an issue that can be raised in a patent infringement suit. (*Trico v. E. A. Laboratories*, 49 Fed. (2) 404, 405; *Andrea, Inc. v. Radio*, 14 Fed. Sup. 226.) If the Petitioner is aggrieved, the Anti-Trust Laws provide him with a way of asking for relief either by going to the Courts or inducing the Department of Justice to do so. The Department of Justice is now investigating the Respondent's "repository of patents" and, if any wrong has been done no doubt the issue of "pooling" will be dealt with before the proper tribunals, in the proper manner and on issues properly made, etc. It would seem that reliance could be placed upon the Department of Justice to deal with the question of pooling, if there is any such question here. Manifestly, that question is presented here for no other reason than a hope that the Court may be led into considering an issue not before the Court.

For the same reason, frequent reference is made to the Aluminum Company of America, who is one of the

licensees under the patents in suit; counsel drag in the most immaterial and remote matters such as the Pomeroy interference* in order to drag in the name of the Aluminum Company. We note from the public press and from reported Court decisions, that the Aluminum Company is being investigated by the Department of Justice, and that should suffice.

(3) **Litigation in a Single Circuit:** Respondent instituted a suit on the patents here involved in Brooklyn, New York, in the Second Circuit, to get an adjudication in another Circuit than the Sixth Circuit on a piston made by the E. M. Smith Corporation of Los Angeles, California, but Sterling Products Corporation of St. Louis, Missouri, who is conducting the proceedings in the instant suit, connived to have that suit go by default; Sterling also left the Eighth Circuit and came into the Sixth Circuit to submit to the jurisdiction of the Courts here, so that Petitioners can hardly complain if the pending litigation is confined to the Sixth Circuit, since they, and not Respondent, are responsible therefor.

Most of the pistons are made and sold by others than motor manufacturers, so that it is unimportant that most of the motor makers are located in the Sixth Circuit.

The Petitioners duplicated the piston shown in the drawing of the Maynard patent, as others have done in other Circuits than the Sixth, but there has been no time to institute suit against any of these since the mandate came down in the instant causes and no need to do so, until it can be determined whether such infringements will cease without suit. We assume that we may, and should properly, await the termination of a test case in one Cir-

* The Aluminum Company had nothing to do with this interference; it was fought and terminated before the Aluminum Company bought the Pomeroy application.

cuit before we proceed to duplicate litigation in other Circuits; likewise, that we may withhold litigation until others have had reasonable time to conform to the rulings of the Court of Appeals in the Sixth Circuit. Moreover, we do not have here a case where the only ruling upon the matter urged is, and always must be, the ruling of one Court of Appeals, since, as we have said, two Courts of Appeals other than the Sixth Circuit Court of Appeals have each decided in favor of the Respondent on the only "error," which Petitioners claim the Court of Appeals made which could be controlling.

The "**Specification of Errors**" are four in number. The only one which is urged as controlling is the first. The second and third relate to cumulative matters only and the fourth is formal.

The "**First Specification of Error**" relied upon for the petition, and the specific error said to have been committed by the three Appellate Courts, and all the tribunals lower to two of them, is an error of law and in fact.

The Law Phase: It is true that a patentee is required to disclose in his patent and in his claim *the elements* of his machine—where his invention is a machine—but it is equally true that he is not required *to describe all the properties of those elements*. (*Eames v. Andrews*, 122 U. S. 40, 56.) When Gulick and Maynard described the *webs* in their specifications that was all that was required of them; they were not required to describe the properties of the webs such as flexibility, hardness, high coefficient of melting point, durability, resiliency, and all the other properties of piston metals. Manifestly, to include in a patent disclosure a description of all properties of all elements and of all the materials of which they are made would make patent claims

and descriptions endless. This Court did not, in *Permutit v. Graver*, in *Powers-Kennedy v. Concrete*, or in any other decision, so hold; neither has any other Court in any other decision so held. The law is, and must needs be, to the contrary; the contrary is the rule in this Court and in all the Circuits (*Eames v. Andrews, supra*; *Diamond v. Consolidated*, 220 U. S. 420, 436; *Jackson v. Peerless*, 228 Fed. 691, 693 (C. C. A. 6); *U. S. Ozone v. U. S. Ozone*, 62 Fed. (2) 881, 890 (C. C. A. 7); *Hoskins v. G. E.*, 212 Fed. 422, 430, affirmed 224 Fed. 464 (C. C. A. 7); *Mead-Morrison v. Exter Mach.*, 225 Fed. 489, 496 (C. C. A. 3); *Novedel v. Meyer*, 35 Fed. (2) 697, 703 (C. C. A. 2); *National v. Interchangeable*, 106 Fed. 693 (C. C. A. 8).

Typical of the statements of these rules is that by Judge Sanborn, speaking for the Eighth Circuit Court of Appeals in *National v. Interchangeable*, and occurring at 106 Fed. 709:

"It is true that Hein did not describe or claim, and it is possible that he was not aware of, the utility of *resiliencé in the beam* when he procured his first patent; but the law did not exact of him a statement or claim of the functions or uses of his combination,"

If counsel were correct, innumerable patents would be invalid on their face for few have ever so extended the description.

These properties are known to those skilled in the art to whom patents are addressed. Description in specification and claims, without naming all their properties, is sufficient to teach those skilled in the art and therefore is sufficient disclosure.

Moreover, if counsel were correct in their contention, or in their contention for what this Court meant in *Permutit v. Graver*, very commonly prior art, and especially that based upon public invention, public use, or the like, would be insufficient, since often there is no description at all of

such prior art except such as is found in models and drawings, and even where there are elaborate descriptions, the engineers or mechanics making such description seldom describe the properties of the materials of which prior art devices are made.

The expert for the Petitioners, as well as for the Respondent, testified that the webs would be flexible and anybody would know that they would be. Petitioners' expert said-(R. p. 568):

"That is, with your knowledge of the piston industry you would know by looking at the drawings (Gulick patent) that those webs would be flexible if the piston was made of material of which you ordinarily made pistons? A. Yes."

Respondent's expert testified (R. p. 201):

"Q. Do you know of any metal of which internal combustion engine pistons are made or have been made which, employed in the construction of the piston illustrated in the drawings of the Gulick patent, would have webs that weren't flexible? A. No.

"Q. State whether or not it would be possible in your opinion to make a piston out of any metal employed for making internal combustion engine pistons and conforming to the drawings of the Gulick patent, without having flexible webs? A. No, it would not be."

* * * * *

At Record page 150 he testified of Gulick:

"Q. Oh, yes. A. Well, then, it is clear enough what he had in mind. These drawings are susceptible of no other interpretation, as I see it. You have got longitudinal rigidity and lateral flexibility."

(See also R. pp. 173 and 1006.*)

* Thus counsel's repeated statement that Respondent's "expert testified that flexibility was not inherent in the web structure" (Petition, p. 19) is flatly contrary to the record and the evidence of both experts.

(Continued on page 9.)

In the *Permutit v. Graver* case, a filtering device was involved which included a filter bed composed of a plurality of grains of zeolite, or like material. The point of novelty of the apparatus consisted in providing a bed with a space above it and (for cleaning) such a current flowing up through it that these grains would be driven upward from the bed by the current, spread out by the current, and then allowed by such current to return to the bed in such a way that they would settle down in a new and different arrangement so as to rejuvenate the filter bed. As this Court said (284 U. S. 56) it was "necessary to have an open space above the top of the zeolites in order to furnish opportunity for the zeolites to rise or boil and to spread out

The petition and briefs thereon are full of half statements and deductions, found erroneous when the record is carefully considered. Such are those in the footnote at the bottom of page 6 of the petition, for example, each of which is contrary to the above statements and to common knowledge. We cannot undertake to correct all of these misstatements and half statements, but will answer those at the bottom of page 6 of the Petition.

At page 229 of the record our expert said, in discussing the pistons including the Ricardo piston, that the flexibility of the web could not be depended upon. This is because the web of the Ricardo piston is so bound by other members that it cannot flex (R. p. 1718). That he was not talking about the Gulick, but was about the Ricardo, is clear from the following question and answer on page 228:

"Q. And the distinction between the Ricardo piston and the Gulick piston is, again, that the Gulick webs are flexible and Ricardo's weren't made that way for flexibility; is that right? A. That is one of the distinctions; of course there are others."

His testimony at pages 149 and 150 was that Gulick "does have a rigid piston longitudinally, and a flexible piston laterally" which is what Gulick originally described. One of the difficulties encountered was the production of a piston which would be rigid vertically but flexible horizontally; that Gulick did and that he did describe in his original specification. Petitioners, as did those before the tribunals and Courts, undertook to change this description around and make it read rigid horizontally, without success in any of the three Courts of Appeals.

(Continued on page 10.)

and reform in the bed." Much more was necessary than a mere free space above the bed. This space had to cooperate with the currents which caused the grains to rise, mixed them up and permitted them to return in a new arrangement to the bed. This Court said (p. 59) "there is no suggestion *on the drawing or elsewhere*" of this operation and function. The most the claims recited in that connection was "a filter bed." Thus the feature which included structure, operation and results was not suggested in the *drawing, in the specification or in the claims* and, of course, the patent (of which this feature alone was new) was invalid for want of disclosure. Such a situation is a far cry from the one involved in the instant case where the web, its operations and what it does are all described and have always

At page 154 our expert testified that the webs could be made non-flexing "if they are made one inch thick," but if you did "you haven't a practical piston at all." By leaving out these qualifications we assume the Petitioner hoped to have this Court believe that the witness was referring to the pistons of the patents in suit concerning which both experts had testified to the contrary, as we have quoted above.

The witness did not say that it was necessary to deliberately design the webs of Gulick to secure flexibility (at either page 156 or page 229 of the record). What he said was that these webs would be flexible in any event, but that deliberate design would, in considering different piston designs, secure the desired flexibility for any particular design but that in any event "*It happens, or it is a fact that the Gulick construction appears to flex a proper amount*" (R. p. 156). We have already pointed out that by the reference at page 229 it was the Ricardo piston and not the Gulick piston which the witness said, in distinguishing therefrom, had flexible webs.

Another one of these half statements, that is fertile with misguidance, occurs in the first footnote at the bottom of page 20 of the Petition. The reference to page 122 of the record there given shows that Dr. Jeffries testified that there were features other than the web which combined with the webs to compensate for the expansion at the top of the Maynard piston and that enough was present "to make the difference practically between success and failure of the piston." He did not say, as counsel contend on the basis of the testimony, that web flexibility was the difference between failure and success.

been described and illustrated in the patents. The complaint is that the patentees did not mention a property, i.e., flexibility of the webs which were known and understood and which both experts say was inherent in the material of the webs. It has always been the law that where a party did not suggest a thing in the drawing, the specification or the claims, the disclosure is insufficient. No new rule of law was made by this Court in *Permutit v. Graver*. It has likewise always been the law that a patentee is not required to describe all of the properties of the materials of which his elements are made. There is not only no conflict between the two rules, but no relation between them.

In *Permutit v. Graver*, the overruled decision of the Circuit Court of Appeals had found, in the drawings, a sufficient disclosure of the unstated "free and unconfined" space above the filter bed by reference to another part of the drawing, the stirrer, which, if operated as described, indicated the free and unconfined character of the top of the filter bed. This Court held that this was going too far in finding disclosure by a drawing. In the drawing of the filter bed itself, there was nothing to show that the top was free and unconfined; there might have been, as there had been in the earlier art, a close fitting cover perforated sufficiently for percolation but an obstruction to boiling up under a current from below.

In other words, the "free and unconfined" character of the top of the filter bed was not inherent in the filter bed structure shown by the drawing and in the operation of that structure as described in the specification, as the flexibility quality was in the Gulick structure as shown and described; but in the *Permutit* case this quality, instead of being inherent in the filter bed shown in the drawing, was to be inferred from the supposed operation of some other part of the structure shown in another part of the drawing.

Petitioners' contention for the interpretation of this Court's decision in *Permutit v. Graver* is not only contrary to the plain language of that decision but, if accepted, would place that decision contrary to the statutes, the practice for more than one hundred years and plain common sense. Although it is a moot question here, the statute requires a single and not a double disclosure. It is common knowledge that engineers and others skilled in the arts, including that to which pistons relate, make their disclosures through drawings hundreds of times where they make disclosures through descriptions once. The drawings are clearer and more accurate in describing than words are or can ever be; the drawings can be understood more quickly than the words; they are also less ambiguous than the words. For anybody to say that these drawings do not disclose the devices depicted in them to those skilled in the art is to say what is not true, because they do, to common knowledge.

If the rule were as Petitioners contend this Court said it was in *Permutit v. Graver*, then much of the prior art which is cited and relied upon in this case and has been relied upon in other cases, often to invalidate patents, would be impertinent, because it is rare that cases of prior invention, prior use, or the like, are established by any other descriptive matter than drawings or models. In better words, it is very rare indeed to find a contemporaneous written description of a prior device, except where it is patented or described in a printed publication, and then one never finds a description so complete as to recite all of the known properties of the elements and the materials employed, as Petitioners say was necessary under this Court's holding in *Permutit v. Graver*.

Nor is there any such conflict between the decisions in the Sixth Circuit Court of Appeals and in the other Circuits as counsel state on page 9 of the Petition. In the two Sixth Circuit cases cited, the Sixth Circuit Court of Ap-

peals said that it did not understand that the general and ancient rule that resort may be had to the drawings and specifications to interpret the claims was affected by this Court's decision in *Permutit v. Graver* and, of course, it was not. This rule is older than the patent law and comes from the rule that where the terms of a contract are ambiguous, resort might be had to collateral matter to clear up the ambiguity. Certainly, if drawings were available which did clear up such ambiguities, they would be available under the general rule. Petitioner's contention that all of this has been changed by this Court's decision in *Permutit v. Graver* is manifestly unsound.

In the cases from the other Circuits which counsel has cited and sought to place in opposition to the decisions in the Sixth Circuit Court of Appeals, the Courts in the other Circuits were merely following the well established rule that where there was insufficiency of disclosure, such as was the case in *Permutit v. Graver*, the patents were invalid for that reason.

Counsel cite too many such cases for us to analyze each one of them; counsel quote from one only of them, i.e., *Helfrich v. Solo*, 59 Fed. (2) 525 (C. C. A. 7). The matter quoted means nothing. The facts mean much. The patent related to a composition of matter used for a face powder. Various ingredients are listed at pages 526 and 527. The invention was bottomed on the ratio of the ingredients and, as the Court said, "*concerning that ratio the patent disclosed no information.*" Moreover, not only was the ratio not within the skill of the art but, as the Court said "no amount of skill or art in following patentee's specification would produce," except accidentally, the result sought. The patentee appreciated this and tried to supply the omitted information regarding the ratio by oral evidence which, of course, the Court said could not be done.

We have carefully combed the reported decisions citing *Permutit v. Graver*, including those referred to by Petitioners; we find that no Court has ever interpreted *Permutit v. Graver* as requiring a patentee to describe a known property of an element or the material of an element employed in his combination; no Court has interpreted this Court's decision as requiring a patentee to describe a property inherent in an element which he did describe. A true and intelligent discussion and application of the rule applied in *Permutit v. Graver* is found in an opinion of the Sixth Circuit Court of Appeals (*Waukesha v. Willys-Overland*, 77 Fed. (2) 906, 909) by Judge Simons who wrote the opinion in the instant cases, sitting with the same Court as sat in the instant cases (Hicks, Simons and Allen, JJ.).

The Fact Phase: Counsel are just as much in error in their facts as they are at sea in their interpretation of the law. While it is true that the term "flexible" was not used in the written descriptions, other terms were used which mean the same thing. The rose, however, is the rose notwithstanding the name. We can best point out counsel's errors and support our statements by quoting from the opinions of the Courts of Appeals who ruled specifically upon this point.

The following from the decision of the Court of Appeals in the District of Columbia (17 Fed. (2) 686) we think is typical of the application of the facts in the instant case to the law:

"The drawings of Gulick, we think, clearly disclose the structure of the count. It is contended, however, that his structure is not such as will 'permit free expansion and contraction of the skirt portion.' But the claim expressly covers this objection in the following language: 'Said skirt being split from top to bottom on one side only of the pin bosses to permit free expansion'.

sion and contraction of the skirt portion.' We think it clear that the object of the split is to permit of this expansion, and, as held by the Board of Examiners, 'under the action of the heat, the circumferential expansion of the skirt would necessarily flex the webs sufficiently to permit the expansion without substantial increase of the diameter of the skirt.' "

The Court of Customs and Patent Appeals concurred in this view (47 Fed. (2) 366-367):

"The main contention of appellant, and the chief subject-matter in controversy in this long and hotly contested interference, is that Gulick's structure does not contain in it means for joining the cylinder engaging parts a resilient yieldability. On this question the tribunals of the Patent Office concur in holding that Gulick's disclosure does show such resilient yieldability and that he can make the claim.

"This part of the issue in this case was before the Patent Office tribunals in an interference case between Gulick and Long. Long contended that Gulick's construction was rigid and could not operate to permit free expansion and contraction of the skirt portion. The Law Examiner held that 'the flanges or ribs 17 and 18 must allow such expansion and it is not material for the present purpose whether they move about one end or are slightly flexed laterally. * * *.' Upon appeal to the Examiners in Chief they said: 'If the webs 17, 18 were so rigid that they would not yield laterally, the slot would have no function.' Upon appeal to the Commissioner, he said: 'The material of which both types of pistons are made will readily yield to the small extent required to bring the piston skirt to the proper diameter. * * *.' Then upon appeal to the Court of Appeals of the District of Columbia, Mr. Justice Van Orsdel, speaking for the court, said: 'We think it clear that the object of the split is to permit of this expansion' and that Gulick had the right to make the claim 'beyond question.' *Long v. Gulick*, 57 App. D. C. 98, 17 F. (2d) 686, 687. The claim there at issue, while somewhat different from the count at bar, called for

a split skirt 'to permit free expansion and contraction of the skirt portion.'

.

"We conclude that Gulick has the right to make the claim."

The contention that the rule followed by the appellate Courts in the above quotations had been revoked or left stranded by this Court's decision in *Permutit v. Graver* was urged upon the Sixth Circuit Court of Appeals with the same fervor that it is urged upon this Court here. Therefore, in adhering to the decisions of the other appellate Courts, the Sixth Circuit Court of Appeals must have fully considered such contentions and rejected them. (R. pp. 2385 and 2391.)

Counsel are likewise confused about this Court's opinion in *Powers Kennedy v. Concrete*, 282 U. S. 175. In that case the patented invention of McMichael was antedated by Leake as the Court said at the top of page 184. The question of identity between McMichael's device and that of the antedating Leake's device was the question discussed by the Court. Mr. Justice Roberts, who wrote the opinion of the Court, finally cited as conclusive proof of identity the fact that McMichael had copied Leake's claims, with the justifiable inference that such copying was an admission of identity. It was for that purpose that the learned Justice made the statement quoted at the bottom and the top of pages 12 and 13, respectively, of the Petition. It is plain that no such interpretation was intended to be given to the language as counsel here seek.*

* It thus becomes clear that the statement at the middle of page 20 of plaintiff's brief regarding the *Powers Kennedy Case* is erroneous. This Court's statement that "This of itself destroys the patent" refers to the admission of identity between the patented invention and the device of the prior art and not to the fact that claims were added. The right of an applicant to amend and add claims is established by authority ancient and current.

Assuming that patent claims may be held invalid when there is a broadening of the claim in the face of adverse intervening rights, such a situation does not exist in the case at bar, first, because there was no broadening of the subject matter claimed since Claim 1 of Gulick was presented in the original application as it now appears in the patent and, second, because intervening rights are not sufficient since such rights must be adverse as well as intervening. The only rights recognized as such in the premises** that intervened in the instant case were those of the plaintiff's licensees and no Court has ever held that a patentee has forfeited any of his privileges under a patent because of the "intervening rights" of those operating under him.

At page 19 of the Petition counsel state their position on the first specification of errors as follows:

"While, at the time the question was presented to the tribunals of the Patent Office and the administrative courts, it was the practice of the Patent Office to permit amendments describing a supposed 'inherent' mode of operation or characteristic of a structure shown only in the drawings of a patent application, that practice was unqualifiedly overthrown by this Court's decision in *Permutit v. Graver, supra*."

It would not matter if it had been the rule in the Patent Office, prior to *Permutit v. Graver*, that a description in a patent specification might be amended to describe characteristics of a structure said to be inherent in the drawing of the patent application, which was not hitherto described in the descriptive part of the specification, for no such thing was done in connection with the Gulick application. What was done there was to merely amplify and state in other words matter which was already described in the specification as well as illustrated in the

** —paper rights have never been so recognized—

drawings. The purpose of this amplification was to make clear to those unskilled in the art what was already clear to those skilled in the art. The following language on this subject appeared in the original Gulick specification (R. pp. 1837-1839):

"One of the objects of the present invention is to provide a piston which is not adapted to expand against the cylinder wall to such an extent as to seize or stick.

"Another object of the invention is to provide a piston with a skirt slightly separated from the head of the piston and split longitudinally so that it will not expand in circumference with a force great enough to cause the piston to stick in the cylinder.

• • • • •

"In order that the skirt may not expand an undue amount when the piston is heated, as under operating conditions, it is split longitudinally as at 21.

• • • • •

"It will be seen that in addition to providing a piston with a split skirt, the above described construction also provides an extremely rigid connection between the piston pin bosses and the skirt of the piston • • • • •"

There could have been no doubt in the minds of anyone skilled in the art who is familiar with piston constructions that the reference to the rigid connection was a reference to the vertical rigidity of the piston which is a characteristic as important as the lateral flexibility, and that the reference to the expansion to the cylinder wall without sticking or seizing was a description of the property of transverse yieldability only. These conclusions follow from several considerations. First, the use of the term "in addition," appearing in the last above quoted paragraph, distinguishes the previous description of the transverse operation from the description of the feature to follow, i.e., the

vertical feature which is said to be "extremely rigid"; second, the use of the word "also" in the same paragraph likewise divides the discussion of the transverse operation from the vertical and distinguishes the two; third, if the term "rigid" were used to mean the vertical, it would respond to the description and the known features of the piston whereas, if it were applied to the piston transversely, the piston would seize and stick and, therefore, fly in the face of the other portions of the description. Counsel offer no proof that this language was not a disclosure to those skilled in the art of vertical rigidity and transverse flexibility. All of those skilled in the art who have discussed this subject, including the many judicial and administrative tribunals to which the Patent Office refers, found that it was a disclosure to those skilled in the art of transverse flexibility and vertical rigidity. We are, therefore, not here confronted either with any such rule as counsel say was current in the Patent Office prior to *Permutit v. Graver* or to any such rule as counsel say was made by *Permutit v. Graver*, but with the rule that a patentee may, during the prosecution of his application, amplify matter contained in the description so that it will be clearer to those skilled in the art and clear to those unskilled, as well. Such has always been the rule in this and other Courts. See *Michigan v. Sutherland*, 29 Fed. (2) 179, 184 where the rule is stated and authorities following the same, including opinions of this Court, are collected and cited by Judge Knappen speaking for the Sixth Circuit Court of Appeals.

The "Second Specification of Errors" presented by the Petition (p. 16) complains that the finding of commercial success by the Court of Appeals was based on the royalties paid the plaintiff by its licensees under its patents. This is incorrect and would be immaterial if correct. The basis

upon which the Court of Appeals found commercial success in the instant case is stated by that Court at page 2388 of the record. After investigating and eliminating all other possible explanations except the merit of the invention, for the wide adoption and use of the patented pistons, the Court concluded that no other alternative inference could be drawn than that the commercial success was due to such inventions and, further, that such was confirmed by the fact that the patented pistons has been adopted only after exhaustive tests by skilled and disinterested engineers working in an industry, which was meticulous and skeptical about the acceptance of new devices, no matter how enticing they appeared from theoretical considerations.

However, before coming to the consideration of commercial success the Court of Appeals had found invention, based upon long and unsuccessful searches for a solution of the problem by those most skilled in the art and the like. (R. pp. 2387-2388.) Such findings alone are sufficient to support the finding of invention (*Expanded Metal* case, 214 U. S. 366; *Temco v. Apco*, 275 U. S. 319). The finding of commercial success was at most, therefore, merely contributory to the finding of invention. It is apparent that invention would have been found in view of the prior efforts and failures to which we have referred even without the further commercial success indicated by the sums of royalties paid. However, as is apparent from the Court's decision, the payment of the royalties, which is ordinarily considered evidence of commercial success, was viewed by the Court of Appeals as so much less important than the other grounds discussed by the Court that the royalties were not even mentioned.

Counsel thus attack the finding of the Court of Appeals on the presumption that such finding was based on the only pertinent evidence on which it was not based.

We think the findings of the Court of Appeals also answer the contention that the success of aluminum pistons was due to such things as the "strength of the hands into which the patent came" and likewise to the contention that it was due to other inventions or to expired patents.

In view of the clear discussion and finding of the Court of Appeals we will content ourselves with denying the allegation that the success of the pistons was attributed by us or our expert to other inventions or other patents. It would lengthen this brief unduly to prove the inaccuracy of all of the erroneous statements in the petition. We think it also clear from the discussion of the Court of Appeals that the licenses were taken because of the merits of the inventions and not because of cross licenses.

The finding of the Court of Appeals that the commercial success was attributable to the patents in suit and not to other patents owned by the plaintiff is based upon the record and the evidence of the witnesses including that of the defendant's own expert who testified that the very identical pistons shown in the Maynard patent were made, sold and used in large quantities. (R. pp. 462, 471 and 955.)

The "Third Specification of Errors" relates to the views of the Court of Appeals upon the presumption of validity of a patent which are as follows (R. p. 2388):

"So also with respect to the presumption that attaches to the validity of a grant by the Patent Office. Where, as in this case, substantially all pertinent prior art has been cited against the patent, where in hard fought interferences novelty and invention have been challenged, and where priority of conception has been finally adjudicated only upon repeated review in both administrative and judicial forums, the patent should not be stricken down except upon very clear and convincing proof of invalidity."

It is stated that these views are wrong where the rule relied upon by the Patent Office and the earlier cases has been reversed by a later decision of this Court. The above finding by the Court of Appeals is in harmony with this Court's decision in *Radio v. Radio* which is later than the decisions of the administrative and judicial tribunals by which the Court of Appeals found the presumption to be strengthened. We know of no later decision of the Court of Appeals, which overcomes the rules relating to presumption of validity expressed by the Court of Appeals and by this Court in *Radio v. Radio*. If counsel mean to repeat their erroneous contentions regarding the finding of this Court in *Permutit v. Graver*, our answer is to be found in our discussion of this decision. We may add, however, that in view of the presumption of validity which arises from all of these decisions, including that of this Court in *Radio v. Radio*, if and when any doubts arise as to the proper interpretation of this Court's decision in *Permutit v. Graver*, they should be resolved in favor of the validity of the patent for the reasons we have stated.

The "Fourth Specification of Error" is merely formal and needs no discussion by us except to say that the Court of Appeals made no error.

The Standing of the Master's Report: Under this heading counsel rely upon the often quoted expression from the opinion of Mr. Justice Holmes in *Adamson v. Gilliland*, i.e., that (under certain circumstances) the Master's report should be "treated as unassailable." Doubtless this expression has led to some confusion in some of the lower courts. Perhaps it should not have done so; but there is no occasion for this discussion here because we take it to be generally understood that for the very purpose of put-

ting an end to such confusion this Court adopted General Equity Rule 61½. Since the adoption of that rule there is obviously no force in contending that the Master's report has any effect excepting that which is carefully stated in that rule. The Circuit Court of Appeals for the Sixth Circuit has always adhered to that view of the Master's report which this Court, by the adoption of Rule 61½, made obligatory upon all the lower courts.

In the instant case, the only theory upon which petitioners appeal to *Adamson v. Gilliland* is that the Master failed to find commercial success. "This evidence failed to convince the Master that any of the patents in suit were commercially successful * * * sufficient to justify his refusal to accredit the patents in suit with commercial success." (Pét. p. 21.) In this respect there is not a scintilla of evidence to support the Master's conclusion. All of the witnesses testifying on the subject, including the defendant's own expert, testified not only that the patented pistons were successful, but that the identical form illustrated in the Maynard patent had gone into wide use. (R. pp. 462, 471, 955.)

Overlapping Patents: Much is said in the brief about overlapping patents and a diagram is arranged on page 5 to support this contention. People often lose sight of the fact that it is the very purpose of the Constitution and the patent laws to encourage the making of inventions and become alarmed when they find that the result aimed at by the Constitution and the patent laws has been achieved. In this achievement it is inevitable that devices originally invented will be improved upon and that the improvements will often be made before the patents upon the original inventions have expired. Thus overlapping patents have become one of the inevitable concomitants of the Constitution

and the patent laws; in fact, such a result was in contemplation and one of the purposes of such rules and laws. This Court has had occasion to recognize and commend such result (*Eibel Process* case, 261 U. S. 45, 63). Counsel's discussion on this subject, as might be truly said of all their discussions, is a challenge to the wisdom and propriety of the provisions in the Constitution about rewards for inventions and the patent laws. Their complaint, in fact, is that inventions should not be made and patents should not be taken out on them. If such were the rules Petitioner and Sterling would have no pistons to make, for up to date the only pistons they have made have been duplications of those made by the complainant's licensees.

Conclusion: It follows that the only alleged error of the Court of Appeals, which is other than cumulative or a determination of which could be more than a declaratory ruling, is the claim of the insufficient disclosure in the Gulick original application and the propriety of the clarification thereof. Three Appellate Courts and numerous other tribunals have held contrary to Petitioners' contention on that point.

In an attempt to find some mote of dissent from these numerous concurring views, counsel grasp at and rely upon the Master's statement that there was "an attempt" to do what all these other tribunals found had not been done. Since this finding of "an attempt" cannot be construed to be a finding of a doing, there is difficulty in finding even a mote of dissent.

Hence, the Petition is no more than a request for a review of the concurring decisions of all the Appellate Courts ruling thereon, and beyond that a request for a review of rulings of the Court of Appeals which counsel claim are erroneous and which would be merely declaratory if brought here and reviewed.

Neither rule of, nor precedent in, this Court is authority for certiorari on such a showing.

We think the Petition should be denied.

Respectfully submitted,

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